

MCK-005.25-US

DEC 16 2005

I, Wayne E. Nacker, Wayne E. Nacker certify that this paper was sent to the United States Patent and Trademark Office by fax, No. 571-273-8300 on December 16, 2005.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Hunt et al.

Art Unit: 1746

Serial No. 09/889,237 Conf. No. 8868

Examiner: Bruce F. Bell

Filed: July 10, 2001

For: EPITAXIAL THIN FILMS

### Request for Reconsideration, in part, of Amendment Pursuant to 37 C.F.R. 1.312

Mail Stop Issue Fee  
Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Reconsideration, *in part*, of the 312 amendment submitted 8 April 2004 is hereby requested. In that amendment, several dependent claims were proposed. The 312 amendment was rejected on 3 March 2005 as introducing "new matter".

In requesting reconsideration, Applicants suggest to drop previously proposed new Claims 27 and 35. Applicants suggest to change previously proposed new Claim 28 so as to be clear that new matter is not introduced, particularly by changing "dielectric layer" to —capacitor—. Of course, when embedding a capacitor in a printed wiring board, the dielectric layer is also invented. However, this substitution would avoid any appearance of new matter.

Although the issue fee was paid 8 April 2004 and the rejection of the 312 amendment was made on 3 March 2005, a patent has, as of this date, not yet issued. Thus, it is believed that the 312 amendment can yet be entered, *in part*.

For the Examiner's convenience, a table has been prepared (appendix B) showing in the first column, the claim number; in the second column, the significant recitation; in the third column, the location of support in the specification, and in the final column, the paragraph where the support is found in corresponding published divisional application S.N. 10/862,605, filed 07 June 2004, publication number 20050019594 A1.

Also, for the Examiner's convenience, a copy of the claims, *as previously proposed*, in the 8 April 2004 312 amendment are attached as appendix A. Again, it is suggested that Claims 27 and 35 be dropped, and proposed Claim 28 be amended to change "dielectric layer" to —capacitor—.

If Examiner Bell has any questions about support of the claims that were newly submitted in the 312 amendment, he is requested to telephone 678 287 3909 (Wayne E. Nacker) or 678 287 3050 (Andrew Hunt) to set up a conference call with first name inventor, Andrew Hunt, and attorney Wayne E. Nacker.

BEST AVAILABLE COPY

DO NOT ENTER  
BFB.